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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,608	01/09/2002	Seiji Yamaguchi	15190	7027
<div>7590 09/06/2007 Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530</div>			<div>EXAMINER GOTTSCHALK, MARTIN A</div>	
			<div>ART UNIT 3694</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 09/06/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/042,608

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Martin A. Gottschalk

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3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. Claims 1-26 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-10, 12, 14-16, 18, and 20-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosow et al (PG Pub# 2003/0074222, hereinafter Rosow).

- A. As per claims 1 and 20-22, Rosow discloses a medical practice information storage and searching system (Rosow: [0009]) comprising:

a medical practice information storage unit for receiving attribute information and medical practice information of a plurality of medical institutions from the plurality of medical institutions through a

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communication line (Rosow: Fig 1, item 20 for example; [0057]-[0059]; Fig 6; [0067]);

a searching criteria receiving unit for receiving, through the communication line, searching criteria in accordance with which the attribute and medical practice information stored in the medical practice information storage unit is searched for (Rosow: [0087]);

and

an information delivery unit for searching for the attribute and medical practice information in the medical practice information storage unit in accordance with the searching criteria received by the searching criteria receiving unit, and for delivering the searched medical practice information through the communication line (Rosow: [0080]).

Note: Applicant has added new claims 23-26 which recite the same features.

A1. As per claim 23-26, Rosow discloses the medical practice information storage and searching system as set forth in claim 1, wherein the attribute information of the plurality of medical institutions includes

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local area information (Rosow: [0014], read on by "geographical information"), and type information (Rosow: [0087], e.g. "medical service").

Note: The remaining claims are rejected substantially for the same reasons as provided in the previous Office Action and are reproduced here for the convenience of the reader. Independent claims 20-22 are rejected for the same reasons as provided above for claim 1.

B. As per claim 2, Rosow discloses a medical practice information storage and searching system according to claim 1, further comprising:

a medical institution information storage unit for receiving medical institution information, identifying a particular medical institution from among the plurality of medical institutions, from the plurality of medical institutions through the communication lines (Rosow: [0010]; [0091]; [0097]; [0101]);

a medical institution searching criteria receiving unit for receiving, through the communication line, searching criteria in accordance with which the medical institution information stored in the medical institution information storage unit is searched for (Rosow: [0087]);

and

a medical institution information delivery unit for searching for the medical institution information in the medical institution information storage unit in accordance with the searching criteria received by the medical institution searching criteria receiving unit, and for delivering the searched medical institution information through the communication line (Rosow: [0080]);

Note: Several of the following claims recite the same three general components of claims 1 and 2, namely

- i. an information storage unit
- ii. a searching criteria receiving unit, and
- iii. an information delivery unit

associated with a specific feature. In the following rejections of the claims, rather than repeating the entire language of the claim, the specific feature will be listed, and relevant passages will be provided. Note further that the reference discloses a computerized system, thus it should be presumed that the information concerning the specific feature is stored, searchable, and deliverable by the features taught by the reference mentioned for claims 1 and 2 above.

C. As per claim 3 Rosow discloses the medical practice information storage and searching system according to claim 2, further comprising:

geographic information (Rosow: [0014]).

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D. As per claim 4, Rosow discloses a medical practice information storage and searching system according to claim 1, further comprising:

request acceptance information (Rosow: [0103]; Fig 25)

E. As per claim 5, Rosow discloses a medical practice information storage and searching system according to claim 1, further comprising:

personal information (Rosow: [0053]; Figs 2, 3, 4; [0101]; Fig 22)

F. As per claim 6, Rosow discloses a medical practice information storage and searching system according to claim 1, further comprising:

transport information (Rosow: [0083])

G. As per claim 7, Rosow discloses a medical practice information storage and searching system according to claim 1, further comprising:

food-service company information (Rosow: [0083]; Fig 1, item 44).

H. As per claim 9, it is rejected for the same reasons as provide above for claim 1.

I. As per claim 10, Rosow discloses a medical practice information storage and searching system according to claim 9, wherein the medical service record information storage block stores

patient count information (Rosow: [0112]-[0113]; [0115]; [0128]; Figs 28 and 29).

J. As per claim 12, it is rejected for the same reasons as provided above from claim 10.

K. As per claim 14, Rosow discloses a medical practice information storage and searching system according to claim 1, wherein the medical practice information storage unit comprises

study result information (Rosow: [0067], reads on "research").

L. As per claim 15, Rosow discloses a medical practice information storage and searching system according to claim 1, wherein the medical practice information storage unit comprises

medical staff information (Rosow: [57]; [60]; [0108]; [0112]; [125]-[126]; Figs 37-38).

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M. As per claim 16, it is rejected for the same reasons provided above for claim 15.

N. As per claim 18, it is rejected for the same reasons provided above for claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosow as applied to claim 1 above, and further in view of Joao (US Pat# 6,283,761, hereinafter Joao).

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A. As per claim 8, Rosow fails to explicitly disclose the features of this claim, however, these features are well known in the art as evidenced by the teachings of Joao who discloses a medical practice information storage and searching system according to claim 1, further comprising:

life insurance information (Joao: col 16, lns 33-65).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Joao within the system of Rosow with the motivation of decreasing the cost of processing insurance claims (Joao: col 2, lns 1-12)

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosow as applied to claim 9 above, and further in view of Mohlenbrook et al (US Pat# 5,018,067, hereinafter Mohlenbrook).

A. As per claim 11, Rosow fails to explicitly disclose the features of this claim, however these features are well known in the art as evidenced by the teachings of Mohlenbrook who teaches a medical practice information storage and searching system according to claim 9, wherein the medical service record information storage block stores

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operation count information (Mohlenbrook: col 9, Ins 17-44; col 10, Ins 65-67).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Mohlenbrook with the system of Rosow with the motivations of a) comparing actual costs to estimated costs for medical or surgical procedures performed in medical institutions and b) estimating the cost of treating a patient at the time of admission to a medical institution so as to allow better cost management during the patient's stay.

8. Claim 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosow as applied to claim 9 above, and further in view of Comanor et al (US Pat# 5,860,917, hereinafter Comanor).

A. As per claims 13, Rosow fails to disclose the features of this claim, however these features are well known in the art as evidenced by the teachings of Comanor who discloses a medical practice information storage and searching system according to claim 9, wherein the medical service record information storage block stores

complete cure rate information (Comanor: col 4, Ins 50-65, reads on "odds of treatment success"; col 14, Ins 7-19; Fig 6).

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B. As per claim 19, Rosow fails to disclose the features of this claim, however these features are well known in the art as evidenced by the teachings of Comanor who discloses a medical practice information storage and searching system according to claim 1, wherein the medical practice information storage unit comprises

medicine information (Comanor: col 5, Ins 38-67).

For claims 13 and 19, it would have been obvious at the time of the invention to one of ordinary skill in the art to combine the teachings of Comanor within the system of Rosow with the motivation of allowing a clinician a more accurate assessment of a patient's treatment options (Comanor: col 7, Ins 61-65).

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosow as applied to claim 15 above, and further in view of DeBruin-Ashton (US Pat# 6,014,629, hereinafter DeBruin-Ashton).

A. As per claim 17, Rosow fails to disclose the features of this claim, however, these features are well known in the art as evidenced by the teachings of DeBruin-Ashton who teaches a medical practice information storage and searching system according to claim 15, wherein the medical staff information storage block stores

physicians' career information (DeBruin-Ashton: col 8, lns 15-22, reads on "specialties").

It would have been obvious at the time of the invention to one of ordinary skill in the art to combine the teachings of DeBruin-Ashton within the system of Rosow with the motivation of identifying the specialties of physicians who previously treated a patient so as to identify physicians of the same specialty to treat the patient (DeBruin-Ashton: col 8, lns 19-22) where the patient has checked into a medical institution for treatment of a current episode.

Response to Arguments

10. Applicant's arguments filed 08/14/2007 have been fully considered but they are not persuasive. On pages 14 and 15 of the response, Applicant essentially argues that the Rosow reference pertains to bed information, and not "medical practice" information. In response the Examiner points out that the beds are hospital beds, and that the system as a whole encompasses information concerning the beds, patients, and the medical institutions serving the beds and patients. See the references provided for representative claim 1 above.

Conclusion

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11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MG
08/29/2007
ELLA COLBERT
PRIMARY EXAMINER